

<b>CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8)</b>			Docket No. UAB-20702/22	
Applicant(s): Steven E. Ealick et al.				
Serial No. 10/035,300	Filing Date October 26, 2001	Examiner Delia M. Ramirez	Group Art Unit 1652	
Invention: <b>MUTANT PURINE NUCLEOSIDE PHOSPHORYLASE PROTEINS AND CELLULAR DELIVERY</b>				
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Steven E. Ealick et al.

Serial No.: 10/035,300

Group Art Unit: 1652

Filing Date: October 26, 2001

Examiner: Delia M. Ramirez

For: **MUTANT PURINE NUCLEOSIDE PHOSPHORYLASE PROTEINS AND  
CELLULAR DELIVERY THEREOF**

**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Responsive to the Office Action mailed April 21, 2004 issued in connection with the above-identified application, please consider the following remarks.

**REMARKS**

In response to the election requirement issued in Paper No. 20040408 mailed April 21, 2004, the Applicant elects to prosecute the invention of Group XX directed in part to a polynucleotide encoding a mutant E. coli purine nucleoside phosphorylase. Applicant makes this election WITH TRAVERSE.

Applicant respectfully requests modification of the restriction requirement to allow the prosecution of Groups I-XX as a unified invention while Groups XXI and XXII likewise are submitted to be entitled to a unified examination, these group designations being those provided by the Examiner in Paper No. 20040408, for the reasons provided as follows in relevant part. Groups I-XX are identified as DNAs that each comprise unrelated nucleic acid sequences.

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Applicant submits that in order to level the outstanding restriction requirement the Examiner has in practice amended the claim scope from "a mutant purine cleaving enzyme" into a recitation of species corresponding to each of the Groups I-XX. There is no basis in the claims submitted for examination for such an action and, indeed, it is respectfully submitted that amending the claims per the outstanding restriction requirement is beyond the authority of the Office. Additionally, it is submitted that dividing the genus of "enzymes" into specific species, even were it allowable according to the MPEP, should result in a species election and not a restriction requirement. On the basis of the above remarks, rejoinder of Groups I-XX is submitted to be appropriate.

Under 35 U.S.C. §121 "two or more independent and distinct inventions . . . in one Application may . . . be restricted to one of the inventions." Inventions are "independent" if "there is no disclosed relationship between the two or more subjects disclosed" (MPEP 802.01). The term "distinct" means that "two or more subjects as disclosed are related . . . but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER" (MPEP 802.01) (emphasis in original). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification;
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, "[i]f the Search and Examination of an entire Application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

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Applicant respectfully submits that Groups I-XX designated by the Examiner fail to define compositions with properties so distinct as to warrant separate examination and search. The Examiner has noted that Groups I, III, V, VI, VII, VIII, XVI and XIX all fall within class 435/195. Groups II, IV, IX-XV, XVII, XVIII and XX all are classified in class 435/193. The search for any of the forms of the inventive compositions separately classified by the Examiner as inventions of Groups I-XX would require an additional search of the identical classes where the materials per se are classified thus resulting in a duplicate search for the same material.

With regard to the criteria detailed in MPEP 808.02, Applicant submits that none of the three criteria are satisfied and that searching class 435, subclasses 193 and 195, because of the intimate relationship between these subclasses, does not represent a burden on the Examiner beyond that required for searching any one of Group I-XX. Thus, Applicant submits that the search and examination of Groups I-XX can be made without serious burden, and therefore the Examiner must examine these claims of the application on the merits.

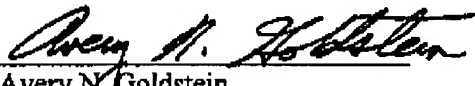
The Examiner's assertion to the contrary notwithstanding, Applicant respectfully submits that conjoint examination and inclusion of all the claims of the present application relating to Groups I-XX would not present an undue burden on the Examiner, and accordingly, modification to include claims 1-33 and 54 in Groups I-XX is believed to be in order.

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**Summary**

Applicant elects with traverse Group XX and respectfully requests that the restriction requirement be withdrawn as improperly creating a de facto amendment of the pending claims. Alternatively, modification of the restriction requirement to include Groups I-XIX is requested.

Respectfully submitted,


  
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**CERTIFICATE UNDER 37 CFR 1.8(a)**

I hereby certify that this correspondence is being sent to the United States Patent Office via facsimile (703-872-9306) on May 21, 2004.

  
Janice R. Kuehn